

## Remarks

The Examiner rejected claims 1–10 as unpatentable under 35 U.S.C §103(a) over Mann '341 in view of Schneider '717. Applicant respectfully traverses the rejections and requests reconsideration for the following reasons.

### Amendments to the specification

Minor amendments are made to paragraphs 0027, 0036, 0038, 0039, 0040 and 0045 to correct inconsistencies and improve inconsistent references to objects in the drawings.

### Internet Domain Name System

By way of background, the DNS or Domain Name System is well known and indeed it enables the World Wide Web to function 24/7 around the world by enabling domain name resolution services. The DNS includes “registries” that maintain databases of domain name registrations (one registry for each top-level domain or TLD, *e.g.*, .com, .net, etc.) and based on that information, domain names can be translated (or “resolved”) into corresponding IP addresses that “point to” the corresponding Internet address (server or host). To acquire or “own” a domain name means that the subject domain name is currently registered exclusively to the “owner” (registrant) in the appropriate registry database.

The domain name system, and more specifically the Shared Registration System (SRS), is described, for example, in the present application, background section (paragraphs 0004 to 0011); Mann at Col. 1, line 14 to Col. 2, line 3; and in Schneider – see Col. 2, lines 24 to 65, SRS – see Col. 4; DNS – see Col. 9, line 40, *et seq*; WHOIS lookup – see paragraph bridging columns 4–5.

“Historically, domain name registration has been conducted through a Shared Registration System (SRS) involving registries, registrars, and registrants. The SRS was created by Network Solutions, Inc. in 1999 to provide a registry backend through which multiple, globally diverse registrars could register domain names. The term “registry” refers to the entity responsible for managing allocation of domain names within a particular name space, such as a TLD. One example of a registry is the VeriSign registry for the .com, .org, and .edu TLDs. ...”

Specification at paragraph [0009].

The term *registry* thus is an established term of art in the field of internet domain name management. It is used as such in the present application and the claims. Importantly, a registry should not be confused with a registrar:

“The term ‘registrar’ refers to any one of several entities with authority to issue commands or requests to add, edit, or delete registrations to or from the registry for a name space. Entities that wish to register a domain name do so through a registrar. The term ‘registrant’ refers to the entity registering the domain name.”

*Id.*

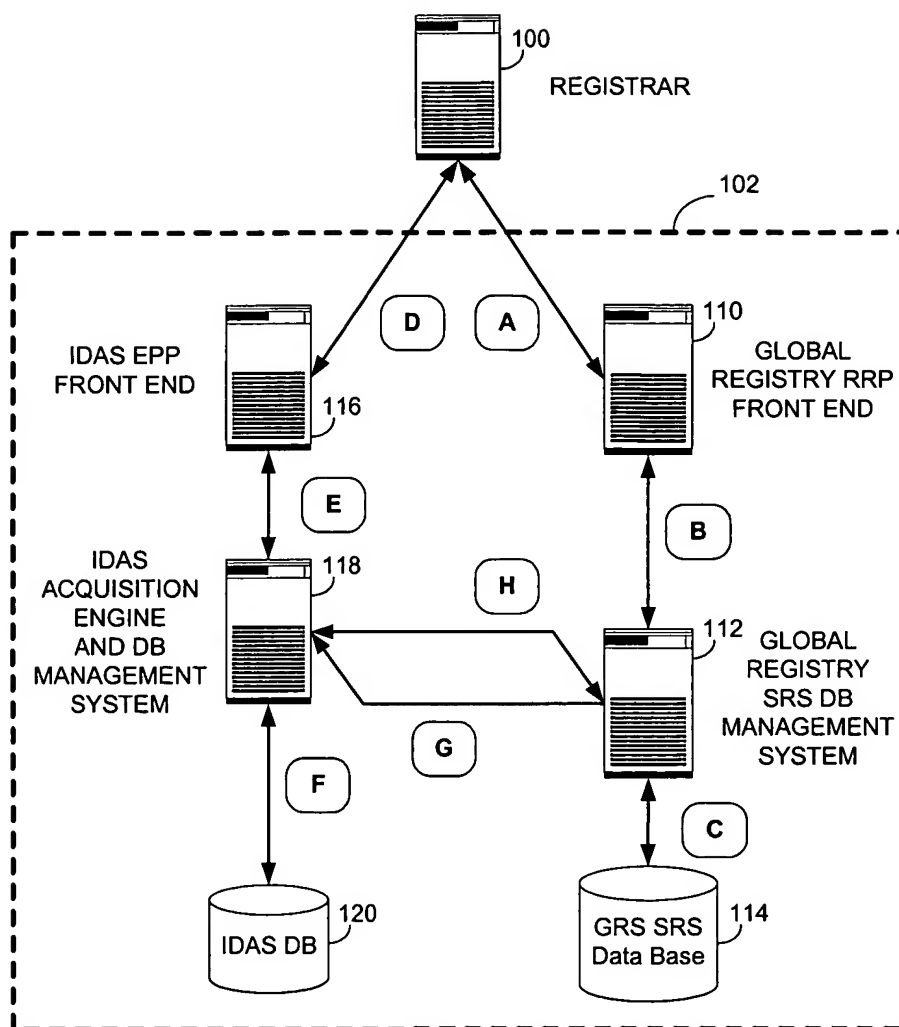
“To effect a registration (renewal), domain name registrants or users must work through a qualified registrar; registrants do not have direct access to the registry (except a read-only lookup or search.) In large part, this is due to the implementation of an SRS, or Shared Registration System. There is only one registry for each gTLD, as domain names must be unique globally.”

Specification at paragraph [0015].

As Schneider explained, “NSI has implemented a SRS to support multiple licensed, accredited registrars offering registration services. NSI and other domain name registrars function as retailers of domain name registration services through NSI’s SRS. NSI will also continue in its role as the registry or wholesaler of ‘.com,’ ‘.net’ and ‘.org’ domain name registrations.” Schneider Col. 4, lines 57-63 (emphasis added).

#### Section 103(a) Rejections Should be Withdrawn

Applicant’s Claim 1 is directed to a novel domain name registry system that supports acquisition (or “reallocation”) of expiring domain name registrations that are not renewed by their current registrants. The term “expiring” is used to refer to a registration that has passed its nominal expiration date but has not yet been purged from the registry database, in other words released to the public. See Abstract. In one embodiment, such a system can be arranged as illustrated in applicant’s FIG. 1, reproduced on the following page:



In this example (not intended to limit the scope of the invention), the objects on the right side of the dashed box, namely the “Global Registry RRP Front End (110),” the “Global Registry SRS DB Management System (112)” and the “GRS SRS Data Base (114),” are all known in some fashion in the prior art. They comprise the registry data base system – used to maintain domain name registration records (in database 114). See specification at paragraph [0033].

The elements on the left side are new, namely the “**IDAS -- Integrated Domain Acquisition Service -- Front End (116),**” the “**IDAS Acquisition Engine and DB (database) Management System (118)**” and the “**IDAS DB (120).**” Claim 1 is set forth below:

“1. A domain name registry system comprising:

[a] a registry database ...

[b] a registry management system ...

[c] an acquisition database containing an acquisition request from a specific registrar to acquire the domain name as soon as practicable following the expiration date and preceding the public delete notification; and

[d] an acquisition engine to receive from the registry management system a pending delete notification, the pending delete notification preceding the public delete notification, to access the acquisition request from the acquisition database, and to request the registry management system to add the new registration for the specific registrar.”

(Letters in square brackets are added for reference.)

The Examiner states that Mann discloses a domain name registry system comprising, first, a registry management system, having access to a registry database containing a current registration record for a domain name, the current registration record having an expiration date. Applicant does not disagree; the domain name registry management system and the registry/SRS database of registration records in general are admitted prior art as explained above.

At least the recited “acquisition database” [c] of applicant’s claim 1 is quite different, however, from the database created by Mann. The Mann system is designed strictly for retrieval of information regarding a domain name; the information is not used for acquisition of a domain name, nor is the Mann system designed to facilitate an acquisition function. In Mann Fig. 1, the database 110 has a predetermined list of “adjunct terms” used to generate a list of candidate domain names by concatenation with a “root terms” input by a user. See Fig. 3A and Col. 4. The system disclosed by Mann also includes a database or “internal list” of domain names. Col. 5, lines 25, *et seq.* Each candidate name is checked against the list for a match. If there is a match, the current candidate name is simply displayed as unavailable for registration. Apparently, the “internal list” might be a list of domain names registered (“sponsored”) by a registrar or other entity providing the Mann-type services. If there is no match, a DNS lookup is conducted, and finally a WHOIS query, all to determine whether or not each candidate name is currently registered or available. Results are sent to the user to select one or more currently

available names for on-line registration. If a candidate name is already registered, it is designated as not available, and accordingly excluded from the “available for registration /transfer” file or log. Col. 6, lines 5-14.

Mann’s database 110, or the described “internal list” of registered names, or even the output list of available names (among the candidate names generated) are quite different from the “acquisition database” of claim 1. Claim 1 calls for, “an acquisition database containing an acquisition request ... to acquire the domain name as soon as practicable following the expiration date and preceding the public delete notification.” (Emphasis added.) Thus, applicant’s claim 1 describes a database of requests to register domain names (not simply of names and their registration status) that currently are NOT available for registration or transfer. This is squarely contrary to the list created by Mann’s system; Mann generates a list of names that ARE currently available, and thus does not advance acquisition of a just-released name — an important feature of applicant’s invention.

Second, according to claim 1, applicant’s acquisition database contains a request, “to acquire the domain name as soon as practicable following the expiration date and preceding the public delete notification.” Thus, the acquisition database is akin to a “waiting list” to obtain registration of a (registered) domain name after the current registration expires, but before it is released to the public (“public delete notification”). As explained in the specification, “The challenge arises in that many users or entities are ‘watching’ for availability of the very same names at the very same registries. The ‘winner’ is the registrar (or individual scripting through the registrar’s connections to the registry) who can ‘grab’ (register) the newly released name before anyone else.” Paragraph [0014].

One solution to this challenge, in accordance with the invention of claim 1, is “to acquire the domain name as soon as practicable following the expiration date and preceding the public delete notification. By acting before the public delete notification, the new registration or reallocation occurs before any other registrar can acquire the expired name. The winner necessarily will be the registrar who earlier entered the request into the acquisition database. To accomplish this result, the system of claim 1 further includes a novel “acquisition engine”:

[d] “an acquisition engine to receive from the registry management system a pending delete notification, the pending delete notification preceding the public delete notification, to

access the acquisition request from the acquisition database, and to request the registry management system to add the new registration for the specific registrar.” Note the communication links indicated by letters “G” and “H” in Fig. 1 above between the acquisition engine (118) and the registry management system (112). See specification at paragraphs [0021-26]. The acquisition engine can compare the “pending delete” (expired but not yet purged from the registry) domain names to the acquisition database, and obtain the requested name(s) as described. In the prior art, registrars and users generally could not attempt to register a name until after it was deleted from the registry and WHOIS data updated. Mann does not suggest any such connection to the registry to receive notice of pending deletions, nor does it suggest a waitlisting function.

The Examiner observed that “Mann does not explicitly state wherein the registry management system has access to manage registration records according to an expiration date.” Schnieder discloses a system to provide integration between domain name resolution and registration services. Briefly, if a web browser is “pointed” to a domain name that cannot be resolved, as it does not appear in the DNS, instead of displaying an error message, the browser is redirected automatically, according to Schneider, to a registrar site to offer the user an opportunity to register the name. (Since the name did not appear in the DNS, it is by definition currently available for registration.) The Examiner apparently misreads Schneider at col. 14, lines 10-15, as that text describes a list of registrars, rather than a registry database. Information about each registrar, such as pricing of registration services, is listed. Additional information, such as length of time to renewal, is understood to refer to generic attributes of each registrar’s services (*e.g.*, one-year or two-year registrations), rather than any specific domain name registration record expiration date.

Moreover, the registration expiration date is actually beside the point here, as the “pending delete” notification by definition occurs *after* the expiration date. The system of claim 1 does not rely on anticipating expiration (As noted earlier, the expiration date of a registration is publicly available). The combination of Mann and Schneider simply does not establish a *prima facie* case for obviousness of the present invention, as they teach only exploration and potential registration of currently available domain names. Further, in the end, entities interested in waitlisting a currently registered domain name would necessarily have to utilize the present applicant’s invention.

And finally, the applicant would respectfully correct the Examiner's assumed relevance of a database including expiration dates—expiration dates of records are common, of course, though not universal, as so indicated in remarks. It is the domain name itself that is expiring, not the database record, and the name's expiration date is part of the predictor set the applicant requires when predicting an acquisition attempt for a domain name.

For the foregoing reasons, claim 1 is patentable over the art of record and it should be allowed.

#### Dependent Claims 2 and 3

Mann teaches a web site interface, as noted by the Examiner, for providing domain name generation services, and associated database apparently storing some registration information. Applicant's "acquisition front end" (claim 2), however, receives requests "from a specific registrar," rather than from an end-user or customer as in Mann's system. And it specifically stores requests in an acquisition database which, as noted above, comprises domain names that are desired but already registered. These features distinguish claims 2 and 3 over the prior art. Implementation of the acquisition front end *in a web server* is not relied upon for patentability.

#### Claims 4 and 5

The Examiner stated that the limitations of claims 4 and 5 were covered in the rejections of claims 1–3, and therefore he rejected claims 4 and 5 "by the same art used in the rejections of claims 1–3." Applicant respectfully traverses these rejections for the reasons explained above as applicable to claims 4–5. In addition, claim 4 is directed to a registry-integrated system. This feature is not suggested in the prior art. Claim 4 reads in pertinent part:

"4. An integrated domain name acquisition system comprising:  
an acquisition database ...  
an acquisition front end system to receive the acquisition request ... and  
an acquisition engine integrated with a registry system to receive from the registry system a pending delete notification for the domain name, the pending delete notification preceding a public delete notification, to access the acquisition request from the acquisition database, and to request acquisition of the domain name for the specific registrar." (Emphasis added.)

The acquisition database and the related acquisition front end are distinguished from the prior art as noted above. In claim 4, the acquisition engine is “integrated with a registry system” to perform the recited functions, including receiving a pending delete notification. Mann and Schneider are NOT at all integrated with a registry system. The Examiner has not pointed out in either Mann or Schneider any suggestion for integrating an acquisition function into the registry itself. *Cf.* specification paragraphs [0021-22]. (In claim 1, the acquisition engine similarly is to receive a pending delete notification, but there it may not be “integrated with a registry system.” For example, the acquisition engine of claim 1 may receive notifications from the registry by other means, such as via the web or email.)

Claims 6-8, according to the Examiner, “recite a method with the same limitations as the system of claims 1-3.” The Examiner therefore rejected these claims based on the same prior art. Applicant does not agree that the claimed method has the same limitations as the system claims; however, the subject matter is similar and therefore applicant respectfully requests reconsideration and withdrawal of these rejections in light of the arguments presented above.

As to claims 9-10, the Examiner also relied on the grounds for rejection set forth in the rejection of claims 1-3, and applicant would likewise request reconsideration and withdrawal of these rejections in light of the arguments presented above with respect to claims 1-5.

#### New Claims

New claims 11-20 are added to more completely claim the invention. These claims are patentable for many of the same reasons explained above. For example, neither Mann nor Schneider disclose or suggest “detecting that the domain name registration has expired; and prior to deletion from the registry, requesting a new registration of the domain name to succeed the expired domain name registration.” (Claim 11.) Claim 17 has a similar limitation, and includes monitoring the status of a registration. The dependent claims recite various ways to monitor that status, leveraging the inventive concept of direct communications with the registry.

#### Drawings

Replacement Sheets are attached corresponding to figures 1-3, respectively, to effect minor corrections. The changes are shown (in red) in the following three sheets, each labeled “Marked-up (‘Red-Lined’) Drawing” at the top. No new matter is added. In Fig. 1, the label on 112 is corrected for consistency with the specification, and the letter “S” is deleted in the



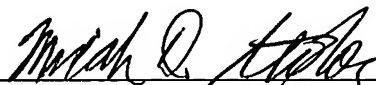
description of the data base 114 as it's in error. ("GS" stands for Global Registry as described in the specification.)

In Fig. 2, at 114, "RRP" is stricken for consistency with FIG. 1; and "RRP 211" is deleted as that reference is not used in the specification. In Fig. 3, reference 200 over line 320 is stricken as an obvious error. The RRP acknowledge ("ACK") add domain message 320 is so labeled; this is simply an acknowledgement of the add domain command 318; and the *query result* message is correctly labeled consistent with the data base query described in the specification at paragraph 0044.

For the foregoing reasons, the pending claims are believed to be patentable and prompt allowance is requested. The undersigned would welcome an interview with the Examiner, by telephone or in person, if it would assist the Examiner. Telephone calls should be directed to Micah Stolowitz at 503-294-9189 (direct line).

Respectfully submitted,

**SnapNames.com, Inc.**

By:   
Micah D. Stolowitz  
Registration No. 32,758

STOEL RIVES LLP  
900 SW Fifth Avenue, Suite 2600  
Portland, Oregon 97204-1268  
Telephone: (503) 224-3380  
Facsimile: (503) 220-2480

## Marked-Up ("Red-Lined") Drawing

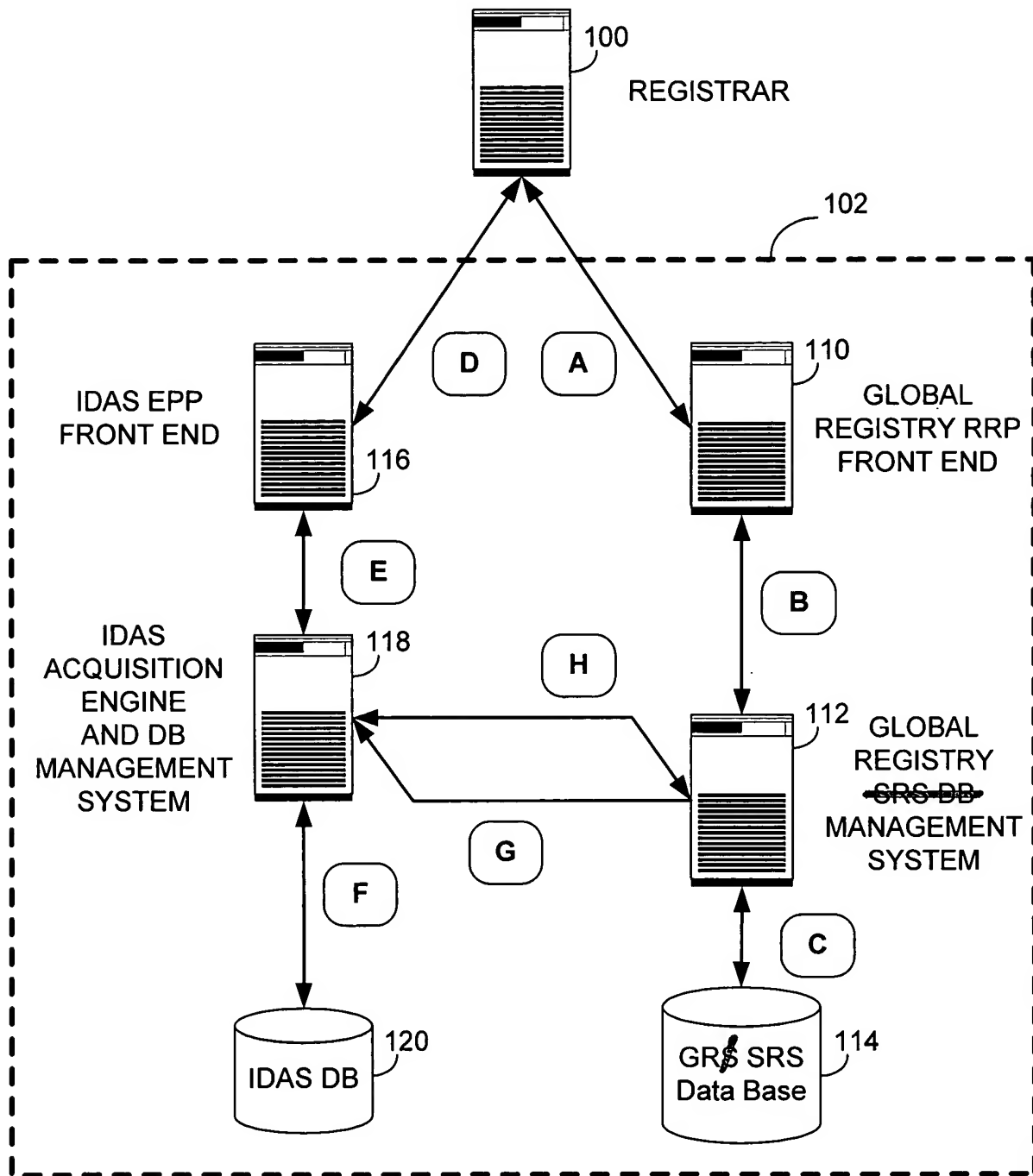


Fig. 1

## Marked-Up ("Red-Lined") Drawing

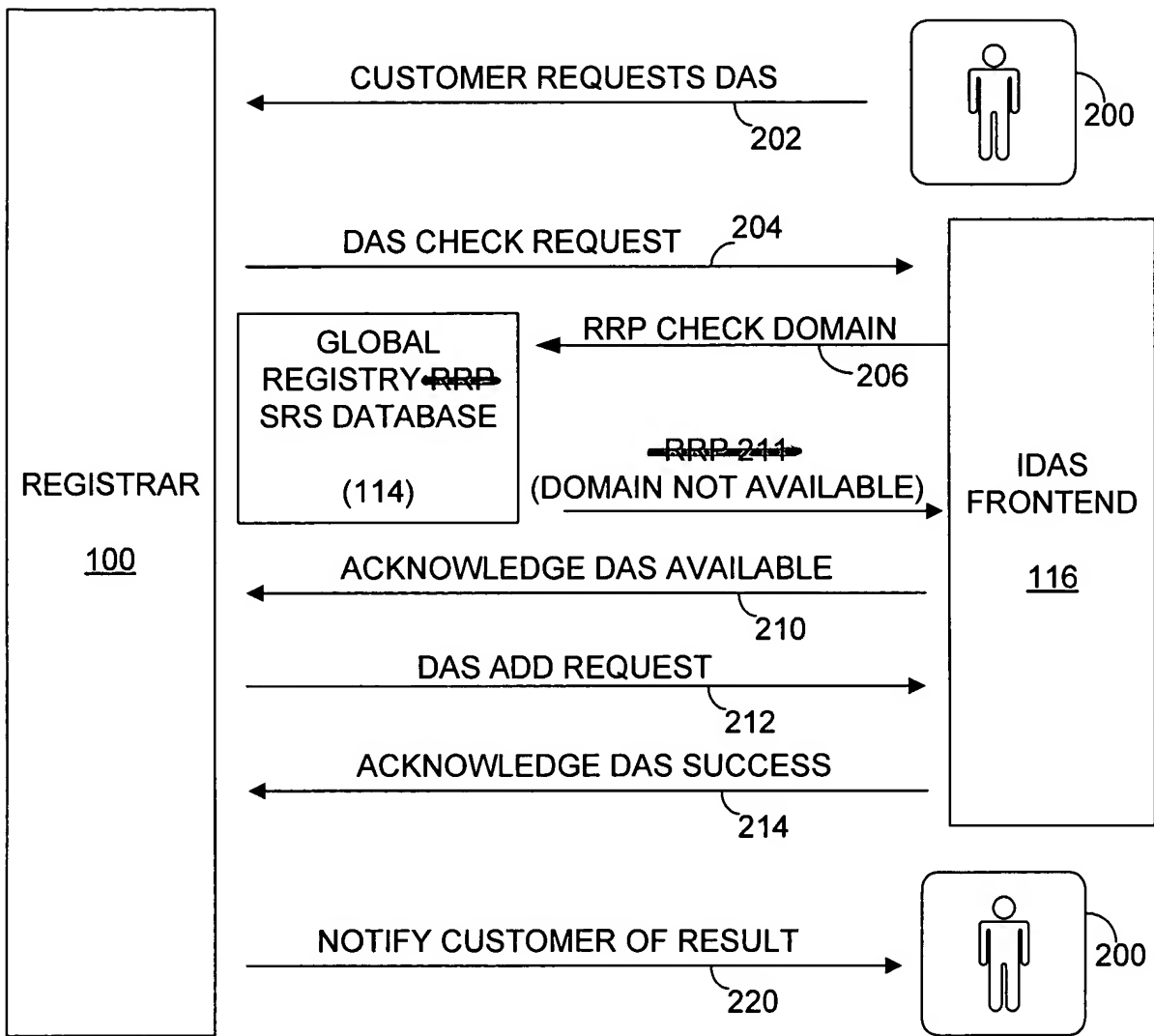


Fig. 2

## Marked-Up ("Red-Lined") Drawing

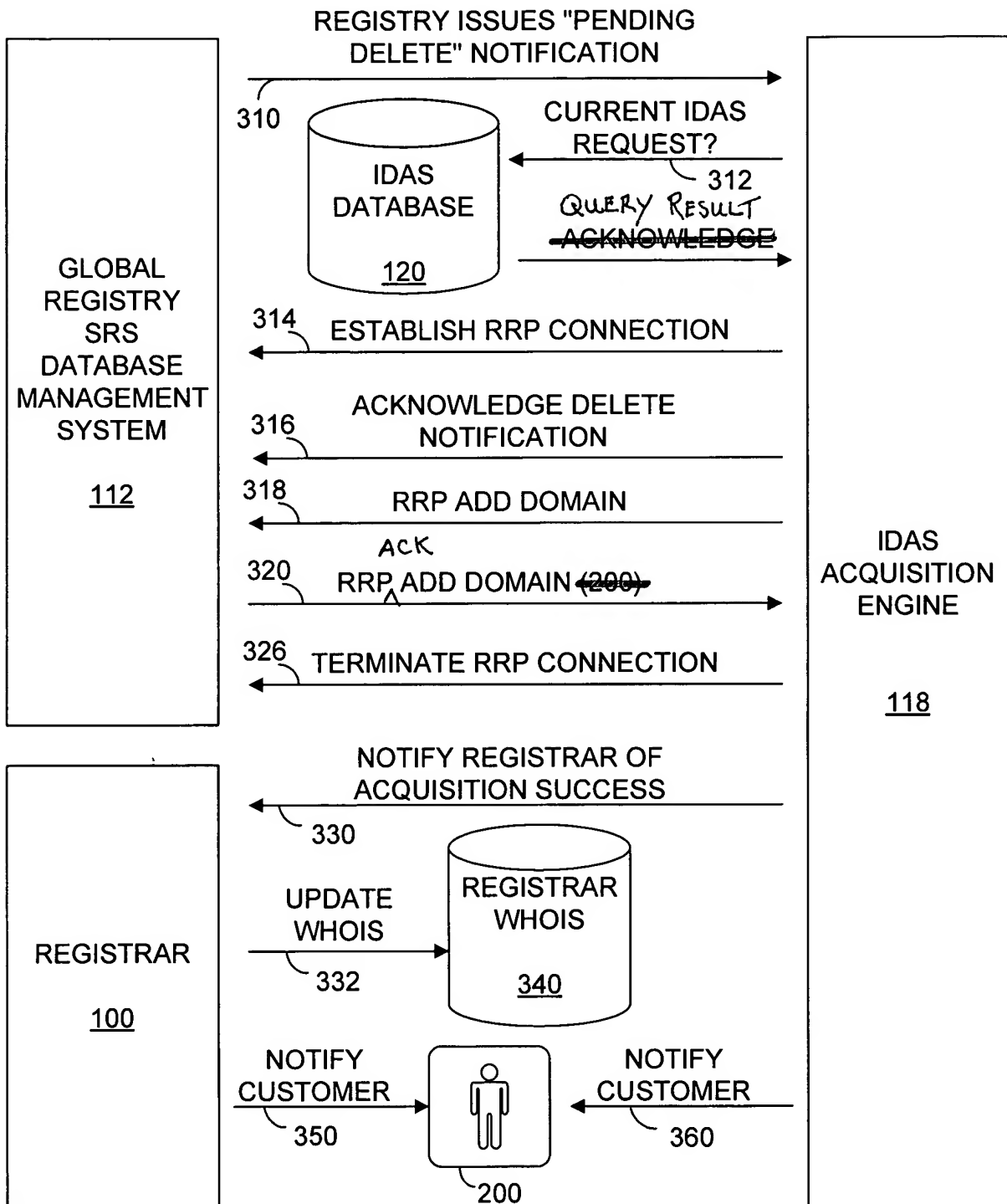


Fig. 3